



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,603	02/22/2002	Masakatsu Kiwada	325772028100	8470

7590 04/05/2007
Barry E. Bretschneider
Morrison & Foerster LLP
2000 Pennsylvania Ave., N.W.
Washington, DC 20006-1888

EXAMINER

MIRZA, ADNAN M

ART UNIT	PAPER NUMBER
----------	--------------

2145

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/079,603

Applicant(s)

KIWADA ET AL.

Examiner

Adnan M. Mirza

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32,34,36 and 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32, 34, 36, 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Applicant's amendment to amend the "Image forming device" with "Printing device" regarded as intended use claim language.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-32, 34, 36, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friday (U.S. 6,631,453) and Kenworthy (U.S. 6,317,837).

As per claims 1,13,17,22,28,36 Friday disclosed an image processing method for printing images on an image printing device based on a file stored in an image printing data transmission device using a portable terminal, said image printing data transmission device connected to a first internal network constructed, inside a first firewall, said image printing device connected to a second internal network constructed inside a second firewall, and a file server connected to an external network constructed on the outside of said first firewall and said second firewall, comprising: said portable terminal establishing a connection with said image data transmission

Art Unit: 2145

device via said second internal network, said second firewall, said external network, said first firewall and said first internal network using a protocol (col. 6, lines 14-41); said image data transmission device receiving said image printing request and preparing a print job to print images associated with said stored file according to said image printing request; said image printing data transmission device establishing a connection with said file server via said first internal network, said first firewall, and said external network using a protocol, which allows connections only from the internal network to the external network at said first firewall (col. 5, lines 42-66); said image data transmission device uploading said prepared print job to said file server; said image printing device establishing a connection with said file server via said second internal network, said second firewall, and said external network using a protocol, which allows connections only from the second internal network to the external network at said second firewall: said image printing device downloading said print job from said file server; and said image printing device printing images based on said downloaded printing job data (col. 17, lines 48-67 & col. 18, lines 1-21).

However Friday did not disclose in detail “which allows bi-directional connections between the first and second internal networks and the external network at said first firewall and said second firewall; said portable terminal transmitting an image printing request for said file stored in said image printing data transmission device to said image printing data transmission device”.

In the same field of endeavor Kenworthy disclosed, “In this way, the NADFW-MS 111 is able to screen a data packet based on particular network node from which the data packet was sent. This

Art Unit: 2145

mechanism provides the NADFW-MS 111 with multi-directional access control (col. 8, lines 11-15).

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have incorporate, "In this way, the NADFW-MS 111 is able to screen a data packet based on particular network node from which the data packet was sent. This mechanism provides the NADFW-MS 111 with multi-directional access control" as taught by Kenworthy in the method of Friday to provide data secure environment for business to business computing.

3. As per claims 2,8 Friday-Kenworthy disclosed comprising said image data transmission device transmitting a storage location data indicating where said uploaded print job is stored on said file server to said portable terminal; said portable terminal receiving said storage location data which said image data transmission device transmitted (Friday, col. 4, lines 29-39); said portable terminal displaying said received storage location data; and said image printing device receiving an entry of said storage location data; wherein said image printing device downloads said print from the storage location on said file server based on said storage location data (col. 5, lines 50-65).

4. As per claims 3,9,33,35,37,39 Friday-Kenworthy disclosed comprising said image data transmission device transmitting a storage location data indicating where said print job is stored on said file server to said portable terminal; said portable terminal receiving said storage location

Art Unit: 2145

data which said image printing data transmission device transmitted; said portable terminal displays said storage location data; said image printing device receives an entry of said storage location data; wherein said image printing device downloads said print job from the storage location on said file server based on said storage location data (Friday, col. 18, lines 51-64).

5. As per claims 4,10,18,23,26,29 Friday-Kenworthy disclosed further comprising said file server transmitting a storage location data indicating where said print job uploaded by said image printing data transmission device is stored on said file server to said portable terminal; said portable terminal receiving said storage location data which said file server transmitted (Friday, col. 18, lines 38-49); said portable terminal displays said storage location data; and image printing device receiving an entry of said storage location data; wherein said image printing device downloads said print job from the storage location on said file server based on said storage location data (Friday, col. 18, lines 51-64).

6. As per claims 5,11,19,30 Friday-Kenworthy disclosed further comprising wherein said file server transmitting a storage location data indicating where said print job uploaded by said image data transmission device is stored on said file server to said portable terminal; portable terminal receiving said storage location data which said file server transmitted (Friday, col. 18, lines 38-49); said portable terminal transferring, said storage location data to said image printing device via said second internal network or a local communication circuit; said image printing device receiving said storage location data transferred by said portable terminal; wherein said

Art Unit: 2145

image printing device loads said print job from the storage location on said file server based on said storage location data (Friday, col. 18, lines 51-64).

7. As per claims 6,12,14,16,20,24,27,31 Friday-Kenworthy disclosed wherein said image printing device is a printer (Kenworthy, col. 3, lines 19-21).

8. As per claims 7,15,21,25,32,34,38 Friday-Kenworthy disclosed an image processing method for printing an image on an image printing device based on a file stored in an image printing data transmission device using a portable terminal, said image printing data transmission device connected to a first internal network constructed inside a first firewall, said image printing device connected to a second internal network constructed inside a second firewall, and a file server connected to an external network constructed on the outside of said first firewall and said second firewall, comprising: said portable terminal establishing a connection with said image printing data transmission device via a public network, a public network authenticating server connected to said first internal network, and said first internal network; said portable terminal transmitting an print job for said file stored in: said image printing data transmission device to said image printing data transmission device (Kenworthy, col. 8, lines 11-15); image printing data transmission device receives said image printing request transmitted by said portable terminal and prepares an image printing data for said file according to said image printing request; said image printing data transmission device establishing a connection with said file server via said first internal network, said first firewall, and said external network using a protocol, which is allows connections only from the first internal network to the external network

Art Unit: 2145

at said first firewall; said image printing data transmission device uploads said prepared print job to said file server; said image printing device establishing a connection with said file server via said second internal network, said second firewall, and said external network using a protocol, which allows connections only from the internal network to the external network at said second firewall; said image printing device downloading said print job from said file server; and said image printing device printing said image based on said downloaded print job (Friday, col. 17, lines 48-67 & col. 18, lines 1-21).

Response to Arguments

Applicant's arguments filed 01/12/2007 have been fully considered but they are not persuasive.

Response to applicant's arguments is as follows. Examiner made several tries to contact the applicant's attorney to help the applicant to expedite the application but failed to reach applicant's assigned attorney.

A. Applicant argued that there is not motivation to combine references and the combination is improper.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

Art Unit: 2145

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Kenworthy taught in the method of Friday provide a firewall to have secure communication between the data component.

B. Applicant argued that prior art did not disclose, “Portable terminal establishing a connection with said image printing data transmission device via said second internal network (col. 2, lines 54-56)”.

As to applicant’s argument Friday disclosed, “establishing an active data connection to the first computer. A passive data connection is established for the second computer” (col. 2, lines 54-56).

C. Applicant argued that prior art did not disclose, “which allows bi-directional connections between the internal network and the external network at said first firewall and said second firewall”.

As to applicant’s argument Kenworthy disclosed, “In this way, the NADFW-MS 111 is able to screen a data packet based on particular network node from which the data packet was sent. This mechanism provides the NADFW-MS 111 with multi-directional access control” (col. 8, lines 11-15).

D. Applicant argued that prior art did not disclose, “establishing a connection with said image printing data transmission device via a public network, a public network authenticating server connected to said first internal network”.

As to applicant’s argument Friday disclosed, “An external system such as Internet or another external system passes a request for information through a router. The router receives the request and passes it into firewall. The firewall has port which is coupled to the router. Data received through the port is sent to an external connector which passes the request to an inspection filter using the process or code extracted from a secure storage device (col. 17, lines 47-57). Is the request deemed to be appropriate by the inspection filter, the request is passed through an internal connection and is considered validated request (col. 18, lines 3-5)”.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Adnan Mirza whose telephone number is (571)-272-3885.

11. The examiner can normally be reached on Monday to Friday during normal business hours. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571)-272-3933. The fax for this group is (703)-746-7239. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2145

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866)-217-9197 (toll-free).



Adnan Mirza

Examiner



JASON CARDONE
SUPERVISORY PATENT EXAMINER